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Paper No. 5

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DEC 04 2001

OFFICE OF PETITIONS

In re Application of :
Griffith, Van Rafelghem, Russell, :
and Hirsch : DECISION REFUSING STATUS
Application No. 09/930,288 : UNDER 37 CFR 1.47(a)
Filed: 16 August, 2001 :
Attorney Docket No. 108214 :

This is in response to the petition under 37 CFR 1.47(a)¹ filed on 16 November, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 16 August, 2001,

¹A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

without an executed oath or declaration. Accordingly, on 19 September, 2001, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring, *inter alia*, a signed oath or declaration and a surcharge for its late filing. In response, on 16 November, 2001, petitioners submitted, *inter alia*, a declaration naming Thomas Griffith, Stefan Van Rafelghem, Stephen Russell, and Ronald Hirsch as joint inventors and signed by joint inventors Griffith, Russell, and Hirsch on behalf of themselves and joint inventor Van Rafelghem; the late-filing surcharge, and the present petition under 37 CFR 1.47(a).

Petitioners assert that Van Rafelghem was sent a copy of the application but failed to execute and return the declaration.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2).

In regards to item (1), petitioners have not provided sufficient proof that a copy of the application was sent to the non-signing inventor. Specifically, petitioners have enclosed a letter from Sally Bauer, Director of Contacts for Avtec Systems, Inc., to Van Rafelghem at his last known address purporting to sent the application. However, the application identified in the transmittal letter is provisional Application No. 60/231,412 rather than the present nonprovisional application. Additionally, the applications identified by invention title at the end of the transmittal letter both have different invention titles than the present application. As such, it is unclear that the present application was sent to the non-signing inventor.

Petitioners may show proof that the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor by providing, with any renewed petition, a copy of the cover letter transmitting the

application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Likewise, before a *bona fide* refusal can be shown, the non-signing inventor must have been given an opportunity to review the application. Therefore, petitioners must show proof that the non-signing inventor refuses to sign the declaration after being sent or given a copy of the application papers.² If there is a written refusal, petitioners should submit a copy of that refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

With regards to item (2), the declaration is defective in that the mailing address listed in the declaration for the non-signing inventor does not appear to be the address at which he customarily receives his mail.³ The object of requiring each applicant's mailing address is to enable the Office to communicate directly with the applicant if desired.⁴ The address listed in the declaration is that of Avtec Systems, Inc., the address *from* which the above-referenced letter to the non-signing inventor was mailed. Obviously, the non-signing inventor cannot be reached at this address. In applications filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.⁵

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

²Id.

³See MPEP 605.30.

⁴Id.

⁵Id.

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision should be directed
to the undersigned at 703-308-6918.



Douglas I. Wood
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy